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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LOVEL, KIMBERLY M

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/786,786	MATSA ET AL.
	Examiner	Art Unit	
	Kimberly Lovel	2167	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>24 February 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/24/04</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 are rejected.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 recites a computer system and a method for using the system.

The claim reads:

A computer system for managing configuration data, the computer system

comprising: an organization module organizing a plurality of configuration values

into a hierarchical tree having a plurality of nodes, a defined structure, and

defined data types for the stored configuration values, wherein each node is

associated with at least one configuration value; storage storing the plurality of

configuration values in the hierarchical tree; a registration module registering at

least one application component with at least one of the nodes of the tree, based

on at least one query received from the at least one application component; and

a notification module notifying the at least one application component when a

configuration value associated with the at least one node is modified, based on

an addition or change in at least one configuration value that matches the at least

one query that matches the at least one query.

Thus, it is unclear whether infringement of claim 17 occurs when one creates a

system that allows an organization module to organize, a storage to store, a registration

module to register and a notification module to notify, or whether infringement occurs

during the actual organizing, storing, registering and notifying. Because claim 17 recites

both a system and the method for using that system, it does not apprise a person of

ordinary skill in the art of its scope and is invalid under section 112, paragraph 2.

IPXL Holdings, LLC v. Amazon.com; CAFC 05-1009, -1487; 21 Nov 2005

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process.

However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at

296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must

either: (A) result in a physical transformation outside the computer for which a practical

application is either disclosed in the specification or would have been known to a skilled

artisan, or (B) be limited to a practical application.

Claim 17 recites a computer system for managing configuration data, the

computer system comprising: an organization module organizing a plurality of

configuration values into a hierarchical tree having a plurality of nodes, a defined

structure, and defined data types for the stored configuration values, wherein each node

is associated with at least one configuration value; storage storing the plurality of configuration values in the hierarchical tree; a registration module registering at least one application component with at least one of the nodes of the tree, based on at least one query received from the at least one application component; and a notification module notifying the at least one application component when a configuration value associated with the at least one node is modified, based on an addition or change in at least one configuration value that matches the at least one query that matches the at least one query.

The computer system can take the form of an entirely software embodiment. Therefore, the claim is directed towards software per se. Software per se fails to produce a tangible result. In order for the subject matter to be considered statutory, it must produce a useful, concrete and tangible result. Claims 18-20 are dependent on the computer system of claim 17, and therefore are rejected on the same grounds as claim 17.

To allow for compact prosecution, the examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 2, 5-10 and 13-18 are rejected under 35 U.S.C. 102(e) as being

anticipated by US PGPub 2003/0204517 to Skinner et al (hereafter Skinner et al).

Referring to claim 1, Skinner et al disclose a method for managing configuration

data, the method comprising the steps of:

storing a plurality of configuration values in a hierarchical tree having a plurality

of nodes (see Fig 5B – the figure represents a hierarchal tree of a client interest registry

and the items contained in the circles are considered to represent the nodes), a defined

structure, and defined data types for the stored configuration values, wherein each node

is associated with at least one configuration value (see [0014] – interest objects are

considered to represent the configuration values; [0045]-[0047] – gives examples of the

defined data types; [0122]-[0123] – the schema is considered to represent the defined

structure);

registering at least one application component with at least one of the nodes of

the tree (see [0014], lines 5-8 and [0057], lines 1-3 – interested components are

registered for each interest object in the hierarchy; the interested components are

considered to represent the *application components*; the interest objects are considered

to represent the *nodes*), based on at least one query received from the at least one

application component (see [0059], lines 6-11); and

notifying the at least one application component when a configuration value

associated with the at least one node is modified, based on an addition or change in at

least one configuration value (see [0057], lines 3-10 – the application component is

notified whenever the data objects associated with the specified interest undergo

modification) that matches the at least one query (see [0059], lines 6-11).

Referring to claim 2, Skinner et al disclose the method of claim 1, wherein the

at least one query depends on at least one of a location of a configuration value in the

tree and a data type of a configuration value (see [0047]; [0059] and [0064] – the query

accesses a particular object; the objects are located in a hierarchal tree and are defined

by classes).

Referring to claim 5, Skinner et al disclose the method of claim 1, wherein a

node further includes a reference to at least one node (see [0077] – each of the

LiveObjectInterest and LiveSet reference the root node since they are registered to the

root node).

Referring to claim 6, Skinner et al disclose the method of claim 1, wherein the

notifying step comprises:

modifying at least one configuration value (see [0058], line 3);

storing in the hierarchical tree the configuration value that was modified (see

[0066], lines 1-5); and

notifying the at least one application component that the configuration value was

modified (see [0058], lines 7-9).

Referring to claim 7, Skinner et al disclose the method of claim 6, further comprising the step of supplying the configuration value that was modified to the at least one application component (see [0066], lines 10-18 – the observer ascertains the updates).

Referring to claim 8, Skinner et al disclose the method of claim 1, further comprising the step of supplying at least one of the configuration values stored in the hierarchical tree to the at least one application component (see [0066], lines 10-18 – the observer ascertains the updates).

Referring to claim 9, Skinner et al disclose a computer program product (see [0027], lines 1-4) for managing configuration data, the computer program product · comprising:

a storage medium readable by a processing circuit and storing instructions for execution by the processing circuit for performing a method (see [0034]) comprising the steps of:

storing a plurality of configuration values in a hierarchical tree having a plurality of nodes (see Fig 5B – the figure represents a hierarchal tree of a client interest registry and the items contained in the circles are considered to represent the nodes), a defined structure, and defined data types for the stored configuration values, wherein each node is associated with at least one configuration value (see [0014] – interest objects are considered to represent the configuration values; [0045]-[0047] – gives examples of the defined data types; [0122]-[0123] – the schema is considered to represent the defined structure);

registering at least one application component with at least one of the

nodes of the tree (see [0014], lines 5-8 and [0057], lines 1-3 – interested

components are registered for each interest object in the hierarchy; the

interested components are considered to represent the *application components*;

the interest objects are considered to represent the *nodes*), based on at least

one query received from the at least one application component (see [0059],

lines 6-11); and

notifying the at least one application component when a configuration

value associated with the at least one of the plurality of nodes is modified, based

on an addition or change in at least one configuration value that matches the at

least one query (see [0057], lines 3-10 – the application component is notified

whenever the data objects associated with the specified interest undergo

modification) that matches the at least one query (see [0059], lines 6-11).

Referring to claims 10 and 13-16, the claims are dependent on the computer

program product for managing configuration data of claim 9. Therefore, claims 10 and

13-16 are respectively rejected on the same grounds as claims 2 and 5-8, which are

dependent on the method for managing configuration data of claim 1.

Referring to claim 17, Skinner et al disclose a computer system (see [0035]) for

managing configuration data, the computer system comprising:

an organization module (see [0048], lines 1-3) organizing a plurality of

configuration values into a hierarchical tree having a plurality of nodes (see Fig 5B – the

figure represents a hierarchal tree of a client interest registry and the items contained in

the circles are considered to represent the nodes), a defined structure, and defined data

types for the stored configuration values, wherein each node is associated with at least

one configuration value (see [0014] – interest objects are considered to represent the

configuration values; [0045]-[0047] – gives examples of the defined data types; [0122]-

[0123] – the schema is considered to represent the defined structure);

storage storing the plurality of configuration values in the hierarchical tree (see

[0028], lines 1-7 – the computer);

a registration module (see [0048], lines 1-3) registering at least one application

component with at least one of the nodes of the tree (see [0014], lines 5-8 and [0057],

lines 1-3 – interested components are registered for each interest object in the

hierarchy; the interested components are considered to represent the *application

components*; the interest objects are considered to represent the *nodes*), based on at

least one query received from the at least one application component (see [0059], lines

6-11); and

a notification module (see [0048], lines 1-3) notifying the at least one application

component when a configuration value associated with the at least one node is

modified, based on an addition or change in at least one configuration value that

matches the at least one query (see [0057], lines 3-10 – the application component is

notified whenever the data objects associated with the specified interest undergo

modification) that matches the at least one query (see [0059], lines 6-11).

Referring to claim 18, the claim is dependent on the computer system for

managing configuration data of claim 17. Therefore, claim 18 is rejected on the same

grounds as claim 2, which is dependent on the method for managing configuration data

of claim 1.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 3-4, 11-12 and 19-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US PGPub 2003/0204517 to Skinner et al as applied respectively to

claims 1, 9 and 17 above, and further in view of US PGPub 2001/0034771 to Hutsch et

al (hereafter Hutsch et al).

Referring to claim 3, Skinner et al disclose a hierarchal tree. However, Skinner

et al fail to explicitly disclose wherein the hierarchical tree is an Extensible Markup

Language (XML) tree, and an XML schema describes the structure of the XML tree and

the data types that are stored. Hutsch et al disclose configuration management using

an hierarchal tree (see [0346] and Fig 15). In particular, Hutsch et al disclose wherein

the hierarchical tree is an Extensible Markup Language (XML) tree, and an XML

schema describes the structure of the XML tree and the data types that are stored (see

[0267] and [0418]).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to the Hutsch et al's feature of an xml tree to replace the tree of

Skinner et al. One would have been motivated to do so since XML provides an

increased ability to accurately capture the structure of the data.

Referring to claim 4, Skinner et al disclose an application component.

However, Skinner et al fail to explicitly disclose the further limitation wherein the at least

one application component comprises a plurality of components of an email application.

Hutsch et al disclose a hierarchical repository for configuration-related and

performance-related information related to computerized systems. In particular, Hutsch

et al disclose wherein the at least one application component comprises a plurality of

components of an email application (see [0091] and [0316]).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use the method of Skinner et al for managing configuration data

to manage the components of email application as discussed by Hutsch et al. One

would have been motivated to do so since email is a widely used application.

Referring to claim 11, the claim is dependent on the computer program product

for managing configuration data of claim 9. Therefore, claim 11 is rejected on the same

grounds as claim 3, which is dependent on the method for managing configuration data

of claim 1.

Referring to claim 12, the claim is dependent on the computer program product

for managing configuration data of claim 9. Therefore, claim 12 is rejected on the same

grounds as claim 4, which is dependent on the method for managing configuration data

of claim 1.

Referring to claim 19, the claim is dependent on the computer system for

managing configuration data of claim 17. Therefore, claim 19 is rejected on the same

grounds as claim 3, which is dependent on the method for managing configuration data

of claim 1.

Referring to claim 20, the claim is dependent on the computer system for

managing configuration data of claim 17. Therefore, claim 20 is rejected on the same

grounds as claim 4, which is dependent on the method for managing configuration data
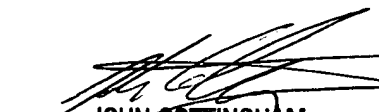
of claim 1.

Contact Information

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-
2750. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Information regarding the status of an application may be obtained from the
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Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly Lovel
Examiner
Art Unit 2167

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28 July 2006

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